

Agilent Ref: 10004108-1  
United States Application Serial No. 10/037,757

### **REMARKS**

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow claims 1-10, 12-24, as well as new claim 26, the only claims pending and currently under examination in this application. Claim 25, which has been withdrawn from consideration by the Examiner, is cancelled herein without prejudice and solely to expedite prosecution of the instant application.

The specification has been amended to insert the term "SEQ ID NO.01" at page 10, line 5 after the provided sequence. In addition, claim 1 has been amended to incorporate the elements of originally pending claims 4 and 11, and the dependent claims on claim 1 have been amended to adapt to this amendment to claim 1. Likewise, claim 14 has been amended to incorporate the elements of originally pending claims 15 and 21, and the dependent claims on claim 1 have been amended to adapt to this amendment to claim 14. In addition, claims 1 and 14 have been amended to specify that the layer between the glass and plastic base blocks at least 10% of the incident light on the front surface of the glass from reaching the plastic base layer. Further dependent claims recite that the layer may be reflective or opaque. Support for this amendment is found in the specification at least at page 15, lines 11 to 15. Claim 26 has been added, support being found in the originally presented claims, among other locations. As the above amendments introduce no new matter, their entry by the Examiner is respectfully requested.

An objection has been raised against the specification for a failure to comply with the Sequence Listing Rules in view of the sequence provided at page 10, line 5. In view of the above amendment and the enclosed Sequence Listing, this objection may be withdrawn. I hereby certify that the enclosed Sequence Listing is being submitted under 37 CFR §§ 1.821(c) and (e) in paper and computer readable form (Compact Disk labeled 'CRF').

### **Certification Regarding Sequence Listing**

As required by 37 CFR 1.821(f), I hereby state that the content of the paper and computer readable copy of the Sequence Listing, submitted in accordance with

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37 C.F.R. §1.821(c) and (e) are the same. The Computer Readable Format (CRF), being submitted under 37 CFR §§ 1.52(e) and 1.824, is formatted on IBM-PC, the operating system compatibility is MS-Windows and the file listing is:

Seqlist.txt 358 B created August 9, 2004.

I hereby certify that the enclosed submission includes no new matter. The Sequence Listing was prepared with the software FASTSEQ, and conforms to the Patent Office guidelines. Applicant respectfully submits that the subject application is in adherence to 37 CFR §§ 1.821-1.825.

An objection has also been raised against the title for being non-descriptive. The claims of the application are directed to chemical arrays, e.g., claims 1 to 10 and 12 to 14, as well as methods for making these arrays. In view of the above amendment to the title, it is respectfully submitted that the title is sufficiently descriptive and no amendment to the title is required.

Claims 8 and 19 have been rejected under 35 U.S.C. § 112, first paragraph for an asserted lack of enablement with respect to the term "reference unit." This lack of enablement rejection is based on the premise that one needs to know the type of Xe lamp employed, as well as the geometry of illumination.

However, the specification teaches that:

"Reference unit" in relation to fluorescence measurements herein means **the maximum fluorescence obtainable** from a fused silica, or one-third the maximum value obtainable from a borosilicate glass. All fluorescence measurements herein, unless otherwise indicated, are integrated fluorescence emission energies from 547 nm to 597 nm, which result from a 1 mm thick section of material, using a monochromated high pressure Xe lamp excitation source centered at 532 nm with a width at half-maximum of about 5 nm. All ratios assume the same unit area of

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illuminated material. The following may be used as the foregoing referenced materials (available from the National Institute of Standards and Technology, Maryland, U.S.A.): fused silica - Standard Sample 198; borosilicate glass - Standard Reference Material 93a. [emphasis added]

Because the definition is tied to the maximum fluorescence obtainable, or a fraction thereof, this necessarily means that one uses the Xe lamp in a manner that provides the maximum fluorescence when determining units. As such, one of skill in the art would find these claims fully enabled and therefore this rejection may be withdrawn.

Claims 14 and 19 have been rejected under 35 U.S.C. § 112, second paragraph for issues related to the wording of these claims. In view of the above amendments to these claims, this rejection may be withdrawn.

Claims 1, 2, 14, 23 and 24 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Rava et al., as defined by the Academic Press Dictionary of Science and Technology. As claim 1 has been amended to include the limitations of claims 4 and 11 (claims not included in this rejection) and claim 14 has been amended to include the limitations of claims 15 and 21 (claims not included in this rejection), this rejection may be withdrawn.

Claims 1-5, 9-16 and 20-24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Chen et al. As amended, all of the cited claims require that the presence of a layer between the plastic and base layers that blocks at least 10% of an illuminating light incident on the front surface of the glass layer from reaching the plastic base layer. Chen fails to teach that a layer, if present between the glass and plastic layers, must have this feature. Chen further fails to teach that the layer may be reflective or opaque as recited in claims. In addition, Chen fails to teach that the such a layer must be present between the glass and plastic layers. Chens fails to teach such a requirement, which is an element of the present claims, because Chen's layer, if present, is taught for a different purpose and, because of this

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different purpose, does not have to be between the glass and plastic layer. Accordingly, Chen fails to anticipate the claimed invention and this rejection may be withdrawn.

Claims 6 and 17 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Chen et al., as defined by the Academic Press Dictionary of Science and Technology. As amended, all of the cited claims require that the presence of a layer between the plastic and base layers that blocks at least 10% of an illuminating light incident on the front surface of the glass layer from reaching the plastic base layer. Chen fails to teach that a layer, if present between the glass and plastic layers, must have this feature, or that the layer, if present must be reflective or opaque, much less that the layer, if present, must be between the glass and plastic layer. Accordingly, Chen et al., as defined by the Academic Press Dictionary of Science and Technology, fails to anticipate the claimed invention and this rejection may be withdrawn.

Claims 7 and 18 have been rejected under 35 U.S.C. § 103(a) as being obvious over Chen et al. However, Chen fails to teach or suggest a structure in which a layer, if present between the glass and plastic layers, must block at least 10% of an illuminating light incident on the front surface of the glass layer from reaching the plastic base layer. Accordingly, Chen fails to render the claims 7 and 18 obvious and this rejection may be withdrawn.

Claims 7 and 8 have been rejected under 35 U.S.C. § 103(a) as being obvious over Chen et al. However, Chen fails to teach or suggest a structure in which a layer, if present between the glass and plastic layers, must block at least 10% of an illuminating light incident on the front surface of the glass layer from reaching the plastic base layer. If a layer is present in Chen, it is taught for a different purpose and need not be between the glass and plastic layers, whereas in the present claims the layer must be present and must be between the glass and plastic layers. Accordingly, Chen fails to render the claims 7 and 8 obvious and this rejection may be withdrawn.

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Finally, Claims 1-24 have been provisionally rejected under the judicially created doctrine of obviousness type double patenting over application serial no. 10/285,759. In view of the enclosed Terminal Disclaimer, this rejection may be withdrawn.

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**CONCLUSION**

The applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Dianne Rees at 650 485 5999. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

Date: September 21, 2004

By:   
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